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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,706	12/19/2000	Bruce A. Schofield	2204/A78	5020

34845 7590 03/11/2005

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EXAMINER
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PHAN, HANH

ART UNIT	PAPER NUMBER
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2633

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/740,706

Applicant(s)

SCHOFIELD, BRUCE A.

Examiner

Hanh Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-8 and 10-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8 and 10-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This Office Action is responsive to the Amendment filed on 08/31/2004.

#### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 3-8 and 10-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 09/929,582 (Schofield). Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations recited in claims 1, 3-8 and 10-28 of the instant application are encompassed by claims 1-18 of copending Application No. 09/929,582 (Schofield).

Regarding claims 1, 8, 16, 17, 22 and 28, Schofield (copending Application No. 09/929,582) discloses an optical add/drop multiplexing apparatus comprising:

a photonic switching fabric operably coupled to drop but not add optical data streams wherein the photonic switching fabric comprises single sided mirrors configurable to drop but not add optical data streams; and

a combiner operably coupled to combine passed optical data streams from the photonic switching fabric together with added optical data streams (see claims 1, 3 and 4 of copending Application No. 09/929,582).

Regarding claims 3, 10, 18 and 23, Schofield (copending Application No. 09/929,582) discloses the added optical data streams are not limited to the wavelengths of the dropped optical data streams (see claims 1, 3 and 4 of copending Application No. 09/929,582).

Regarding claims 4 and 11, Schofield (copending Application No. 09/929,582) discloses wherein the combiner is a passive coupler (see claims 1, 3 and 4 of copending Application No. 09/929,582).

Regarding claims 5, 12, 19 and 24, Schofield discloses the combiner comprises filter logic for blocking an out of band optical data stream (see claims 1, 3 and 4-10 of copending Application No. 09/929,582).

Regarding claims 6, 13, 20 and 25, Schofield discloses a demultiplexer operably coupled to de-multiplex, optical data streams from an incoming fiber and provide the demultiplexed optical data streams as inputs to the photonic switching fabric (see claims 1, 3 and 4 of copending Application No. 09/929,582).

Regarding claims 7, 14, 21 and 26, Schofield discloses the photonic switching fabric is operably coupled to output the dropped optical data streams separately from

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the passed optical data streams (see claims 1, 3 and 4-10 of copending Application No. 09/929,582).

Regarding claims 15 and 27, Schofield discloses each added optical data stream is maintained in-band using controls external to the combiner (see claims 1, 3 and 4 of copending Application No. 09/929,582).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-8 and 10-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiang et al (US Patent No. 6,449,407) in view of Bortz (US Patent No. 6,771,905).

Regarding claims 1, 8, 16, 17, 22 and 28, referring to Figure 4, Kiang discloses an optical add/drop multiplexing apparatus comprising:

a photonic switching fabric (Fig. 4) operably coupled to drop optical data streams wherein the photonic switching fabric comprises single sided mirrors; and

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a combiner (i.e., multiplexer 404, Fig. 4) operably coupled to combine passed optical data streams from the photonic switching fabric together with added optical data streams (col. 6, lines 5-58).

Kiang differs from claims 1, 8, 16, 17, 22 and 28 in that he fails to teach the add signals are not inputted to the photonic switching fabric. However, Bortz in US Patent No. 6,771,905 teaches the add signals are not inputted to the photonic switching fabric (Figs. 2c and 5a, col. 14, lines 3-5, col. 11, lines 20-27 and col. 7, lines 35-45).

Therefore, it would have been obvious to one having skill in the art at the time the invention was made to incorporate the add signals are not inputted to the photonic switching fabric as taught by Bortz in the system of Kiang. One of ordinary skill in the art would have been motivated to do this since Bortz suggests in column 14, lines 3-5, col. 11, lines 20-27 and col. 7, lines 35-45 that using such the 14, lines 3-5, col. 11, lines 20-27 and col. 7, lines 35-45 have advantage of allowing reducing the signal loss, crosstalk between the signals, increasing signal to noise ratio and reducing the cost of the device.

Regarding claims 3, 10, 18 and 23, the combination of Kiang and Bortz teaches the added optical data streams are not limited to the wavelengths of the dropped optical data streams (Figs. 2c and 5a of Bortz).

Regarding claims 4 and 11, the combination of Kiang and Bortz teaches wherein the combiner is a passive coupler (col. 8 of Bortz, lines 6-7).

Regarding claims 5, 12, 19 and 24, the combination of Kiang and Bortz teaches the combiner comprises filter logic for blocking an out of band optical data stream (col. 8 of Bortz, lines 6-7 and col. 6, lines 52-66).

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Regarding claims 6, 13, 20 and 25, the combination of Kiang and Bortz teaches a demultiplexer operably coupled to de-multiplex, optical data streams from an incoming fiber and provide the demultiplexed optical data streams as inputs to the photonic switching fabric (col. 8 of Bortz, lines 6-7 and col. 6, lines 52-66).

Regarding claims 7, 14, 21 and 26, the combination of Kiang and Bortz teaches the photonic switching fabric is operably coupled to output the dropped optical data streams separately from the passed optical data streams (Figs. 2c and 5a of Bortz).

Regarding claims 15 and 27, the combination of Kiang and Bortz teaches each added optical data stream is maintained in-band using controls external to the combiner (Figs. 2c and 5a of Bortz).

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1,3-8 and 10-28 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh Phan whose telephone number is (571)272-3035.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan, can be reached on (571)272-3022. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-4700.

  
**HANH PHAN**  
**PRIMARY EXAMINER**